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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/398,229	09/17/1999	JONATHAN J. HULL	74451.P100	9798

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EXAMINER

FLYNN, KIMBERLY D

ART UNIT PAPER NUMBER

2153

DATE MAILED: 05/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/398,229

Applicant(s)

HULL ET AL.

Examiner

Kimberly D Flynn

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. Claims 14 - 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In considering claims 14, the limitation stating the following: “ a multifunction machine unconsciously sending an electronic document to a server” is indefinite or mis-descriptive. It is not clear as to how a machine can send a document unconsciously. The term “unconscious” is not generally associated with computers.

Claims 15 and 16, depend from claim 14, and are thus rejected as well.

In considering claim 17, 22, and 28, the limitation stating the following: “ receiving an unconsciously captured electronic document at the server” is mis-descriptive or unclear. It is unclear as to how a server can receive an unconsciously captured document, and also how a document can be unconsciously captured. The term “unconscious”, is not generally associated with computers.

Claims 18-21, depend from claim 17, and are thus rejected as well.

Claims 23-27, depend from claim 22, and are thus rejected as well.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 1, 14, 17, 22, and 28, are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolff (U.S. Patent No. 5,848,413 hereinafter, Wolff) in view of Bauer et al. (U.S. Patent No. 6,188,673 hereinafter, Bauer).

In considering claims 1, Wolff discloses a system for publishing electronic documents on a network (*see. Fig 7*) comprising:

a multifunction machine to supply the electronic document (*col. 7, lines 29-39*);

a filter to transform the electronic document for publication (*col. 7, lines 40-49*);

a server having memory for storing the electronic document, wherein the server permits access to the electronic document using a document identifier (*col. 7, line 50-67 through col. 8, line 3*).

However Wolff fails to disclose wherein the server sends, to a publisher designated location, information regarding the number of accesses that have occurred. Nonetheless, access counters that count the number of "hits" that a web pager or web server receives is well known in the Internet art as evidenced by Bauer. In similar art, Bauer discloses a system that uses web page hit statistics to anticipate call center traffic wherein a CGI script is invoked each time a user

accesses a page and thereby causing the Web server to report the number of accesses to the Call Management System (*Col. 4, lines 28-40*).

Access counters provide web publishers with statistical information needed for accounting purposes such as tracking the amount of traffic on a particular site. It would have been advantageous to modify the system taught by Wolfe to include an access counter so that once the document was published, the publisher would have a record of recent page hits along with a historical record of page hits.

Thus, given the teaching of Bauer, a person having ordinary skill in the art would have recognized the advantages of using an access counter in order to keep track of the volume of hits that a particular published document have been accessed. Therefore, the aforementioned limitations would have been an obvious modification to the system taught by Wolff.

In considering claim 2, although the combined system of Wolff and Bauer discloses substantial features of the claimed invention, it fails to disclose wherein the number of accesses occurred comprise zero or more accesses. Access counters are well known in the Internet art, and therefore, it would have been obvious to a person having ordinary skill in the art to recognize that the access counter would comprise zero or more accesses indicating whether the site has not been accessed (zero) or that the site has been accessed at least the number of times as indicated by the counter.

In considering claim 3, Wolff further discloses wherein the multifunction machine comprises a print driver that publishes the electronic document on a network (*col. 3, lines 35-37*).

In considering claim 4, Wolff further discloses wherein the document identifier comprises a URL (*col. 7, lines 55-57*).

In considering claims 8, the combined system of Wolff and Bauer discloses wherein the server maintains access logs and updates the access logs each time the server is accessed (*See Bauer, col. 5, lines 46-48*).

In considering claims 9-10, the combined system of Wolff and Bauer discloses a server comprising a system manager that is capable of accessing the access logs (*See Bauer, col. 5, lines 37-44*).

In considering claims 11-12, the combined system of Wolff and Bauer discloses wherein the system manager notifies the publisher automatically, by sending an electronic mail message; indicative of whether the document was accessed by a user (*See Bauer, col. 4, lines 62-67*).

In considering claim 15, Wolff further discloses wherein sending the electronic document comprises a multi-function machine printing the electronic document (*col. 7, lines 29-39*).

In considering claims 16 and 27, although the system taught by Wolff discloses substantial features of the claimed invention it fails to disclose wherein the server generates a security key. However Wolff does disclose wherein the server allows access to the document by creating an identifier/locator for the document. Thus, a person having ordinary skill in the art would have recognized the desirability generating a security key as well as an identifier so that the server would not only allow access to the document, but also authorized access to the documents. Therefore, the claimed limitation would have been an obvious modification to the system taught by Wolff.

In considering claims 18 and 23, Wolff further discloses wherein the server notifies a user that an electronic mail message containing a URL has been sent from the server (*col. 7, lines 55-62*).

5. Claims 5-7, 19-21, and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolff in view of Bauer in further view of Skarbo et al. (U.S. Patent No. 6,317,777 hereinafter, Skarbo).

In considering claim 5-7, 19-21, and 24-26, although the combined system of Wolff and Bauer discloses substantial features of the claimed invention, it fails to disclose wherein the server deletes or prevents access to the document based on certain conditions. The conditions being when an authorized user accesses the document after the document has been stored on the server for a predetermined amount of time, or if the document had been accessed a predetermined number of times. Nonetheless, the auto-deletion of documents based on certain conditions is well known as evidenced by Skarbo. In similar art Skarbo discloses a system and method for web based storage and retrieval of documents wherein administrative options may be set pertaining to documents such as the auto-deletion after n days, displaying user access rates, and resources used (*col. 7, lines 9-18*).

Thus given the teachings of Skarbo a person having ordinary skill in the art would have recognized the desirability to modify the combined system of Wolff and Bauer to include the maintenance options, described above, so that the publisher of the documents would have control over the documents' accessibility. Therefore, the claimed limitations would have been obvious modifications to the combined system of Wolff and Bauer

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

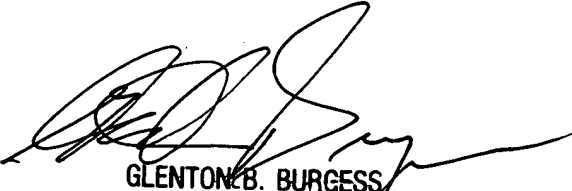
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly D Flynn whose telephone number is 703-308-7609. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 703-305-4792. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7240 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Kimberly D Flynn
Examiner
Art Unit 2153

KF
May 1, 2002


GLENTON B. BURGESS
SUPERVISORY PATENT EXAMINER
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